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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,211	02/12/2002	Paul Trpkovski	44046.103.203.21.2	9015
22859	7590	11/18/2005	EXAMINER	
INTELLECTUAL PROPERTY GROUP FREDRIKSON & BYRON, P.A. 200 SOUTH SIXTH STREET SUITE 4000 MINNEAPOLIS, MN 55402			A, PHI DIEU TRAN	
			ART UNIT	PAPER NUMBER
			3637	

DATE MAILED: 11/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/076,211

Applicant(s)

TRPKOVSKI, PAUL

Examiner

Phi D. A

Art Unit

3637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6,8-12,48-51 and 55-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,6,8-12,48-51,55-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 3637

1. In view of the Appeal Brief filed on 8/17/05, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

LANNA MAI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600



With respect to the limitation of "glazing compound" in claims 1, 6, 8-12, the limitation is not claimed and is thus treated accordingly as a subcombination with the other claimed structures.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 6, 12, 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. (5866260) in view of Calabrese (2657795) and Hurst (3900102).

Adams Jr. et al shows a transparent window pane (18) having first and second generally opposed major surfaces (20, 21) being sized and shaped to be mounted in a frame configured to received at least one edge of the pane (figures 5b, 6b), the pane having a removable protective covering (22) disposed over a central portion of the first surface and that extend across a length of the first surface or across a width of said surface, the central portion spanning at least 70% of the first surface, the first surface having an unmasked peripheral apron, the masking material being a transparent film (col 3 line 45), the unmasked apron extends between an outer periphery of the protective covering and an outer periphery of the pane, the covering being attached to the first major surface by masking adhesive (inherently being masking adhesive as the adhesive is made to be removed with the masking cover), the masking material being translucent or transparent (col 3 lines 44-45).

Adams Jr. et al does not show the protective covering having a plurality of strips of masking material that are disposed over a central portion of the first surface, the strips of masking material being disposed in a sequentially overlapping fashion with each subsequent strip overlapping a portion of a preceding strip, the strips extending substantially in parallel across the

Art Unit: 3637

first surface of the pane, the strips being adhesively attached to the first major surface by a masking adhesive, the overlapped strips of masking film defining a plurality of exposed lateral edges that form readily accessible means, the strips are affixed to one another by adhesive.

Hurst discloses a plurality of sequentially overlapping strips covering a large central portion of a first surface of a structure, the strips are to sealed surfaces sound in buildings and civil engineering structures (col 1 lines 14-16), the strips are affixed to one another by adhesive, the strips extending substantially parallel across a first surface of the structure, the strips defining a plurality of exposed lateral edges.

Calabrese discloses a protective covering having a plurality of strips (12-14) of masking material covering an area to be left unpainted.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams Jr. et al to show the protective covering having a plurality of strips of masking material that are disposed over a central portion of the first surface as taught by Calabrese, the strips of masking material being disposed in a sequentially overlapping fashion with each subsequent strip overlapping a portion of a preceding strip, the strips extending substantially in parallel across the first surface of the pane, the strips being adhesively attached to the first major surface by a masking adhesive, the overlapped strips of masking film defining a plurality of exposed lateral edges that form readily accessible means, the strips are affixed to one another by adhesive as taught by Hurst because having the multiple strips of masking material disposed over a large central portion of a first surface would protect the central portion of the structure from being painted thereon as taught by Calabrese, and having the strips extending substantially in parallel across the first surface of the pane, the strips being adhesively attached to

Art Unit: 3637

the first major surface by a masking adhesive, the overlapped strips of masking film defining a plurality of exposed lateral edges that form readily accessible means, the strips affixed to one another by adhesive would allow for the formation of a continuous membrane over the whole surface as taught by Hurst.

3. Claims 1, 6, 12, 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagashima et al (6461736) in view of Adams Jr. (5866260).

Nagashima et al shows a transparent window pane (2, figures 1-2) having first and second generally opposed major surfaces being sized and shaped to be mounted in a frame configured to received at least one edge of the pane, the pane having a removable protective covering (5, 4, 3) disposed over a central portion of the first surface and that extend across a length of the first surface or across a width of said surface, the central portion spanning at least 70% of the first surface, the protective covering having a plurality of strips (5, 4, 3) of masking material that are disposed over a central portion of the first surface, the strips being disposed in a sequentially overlapping fashion with each subsequent strip overlapping a portion of a preceding strip (figure 1 shows three strip overlapping each other and each strip comprises of 5, 4, 3), the masking material being a transparent film, the covering being attached to the first major surface by masking adhesive (inherently being masking adhesive as the adhesive is made to be removed with the masking cover), the masking material being translucent or transparent, the strips being substantially parallel across the first surface of the pane, the overlapped strips of masking film defining a plurality of exposed lateral edges that form readily accessible means, the strips are affixed to one another by adhesives.

Art Unit: 3637

Nagashima et al does not show the first surface having an unmasked peripheral apron, the unmasked apron extends between an outer periphery of the protective covering and an outer periphery of the pane.

Adams Jr. shows the first surface having an unmasked peripheral apron, the unmasked apron extends between an outer periphery of the protective covering and an outer periphery of the pane.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Nagashima et al's structure to show first surface having an unmasked peripheral apron, the unmasked apron extends between an outer periphery of the protective covering and an outer periphery of the pane as taught by Adams Jr. because it would enable the pane to be mounted onto a frame without interfering with the film.

4. Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. (5866260) in view of Hurst (3900102) and Calabrese (2657795) as applied to claimed 1 above and further in view of Bargados et al (5809707)

Adams Jr. et al as modified shows all the claimed limitations except for the covering being sized, shaped, and positioned such that at least one/all peripheral side portion of the covering extending significantly beneath a confronting surface of the frame when the pane is mounted, the peripheral side portions of the covering does not extend so far beneath the confronting surface of the frame as to engage glazing compound between the frame and the pane.

Bargados et al discloses covering (24) being sized, shaped, and positioned such that at least one/all peripheral side portion of the covering extending significantly beneath a confronting surface of the frame(18) when the pane is mounted, the peripheral side portions of the covering

Art Unit: 3637

does not extend so far beneath the confronting surface of the frame as to engage any glazing compound between the frame and the pane(inherently so as there is no glazing compound), the cover may be able to provide paint resistance.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams Jr. et al's modified structure to show the covering being sized, shaped, and positioned such that at least one/all peripheral side portion of the covering extending significantly beneath a confronting surface of the frame when the pane is mounted, the peripheral side portions of the covering does not extend so far beneath the confronting surface of the frame as to engage glazing compound between the frame and the pane as taught by Bargados et al because it would enable Adam Jr. et al's modified cover to hide the edges of the cover in a groove in the frame as taught by Bargados et al.

5. Claims 48-51,55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. (5866260) in view of Calabrese (2657795), Bargados et al (5809707) and Emmanuel (5836119).

Adam Jr. et al shows a glazing assembly having a transparent pane (18) and a frame (26) to which the pane is mounted, the frame receives an edge of the pane, the pane having first and second generally opposed major surfaces (20b, 21b), at least one edge received in the frame, the pane having a protective covering (22b) disposed over a portion of the first surface, the first surface having an unmasked apron (the surface not covered) extending between an outer periphery of the covering an outer periphery of the pane, the covering consisting of a single sheet of masking material, the masking material being a masking film (transparent layer), the pane being part of a multiple pane insulating glass unit (col 1 lines 49-51), the pane being mounted

Art Unit: 3637

such that all edges of the pane being received in the frame (figure 5b, 6b), the masking material being flexible.

Adams Jr. et al does not show the protective covering comprising a plurality of strips of masking material, at least one piece of the masking material having at least one/all peripheral side portion extending significantly beneath a confronting surface of the frame, the side portions extending a predetermined distance beneath the confronting surfaces of the frame, a glazing compound between the pane and the frame.

Calabrese discloses a protective covering having a plurality of strips of masking material to cover an unpainted surface.

Bargados et al shows at least one piece of cover material (24) having at least one/all peripheral side portion extending significantly beneath a confronting surface of the frame (18), the side portions extending a predetermined distance beneath the confronting surfaces of the frame, the edges of the covering being inside grooves to hide the edges.

Emmanuel shows a glazing compound (83) connecting the frame and pane together.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adam jr. et al to show the protective covering comprising a plurality of strips of masking material as taught by Calabrese, at least one piece of the masking material having at least one/all peripheral side portion extending significantly beneath a confronting surface of the frame, the side portions extending a predetermined distance beneath the confronting surfaces of the frame as taught by Bargados et al, a glazing compound between the pane and the frame as taught by Emmanuel because having the covering made of a plurality of strips would enable easy covering of a large area before painting as taught by Calabrese, having

Art Unit: 3637

the at least one/all peripheral side portion extending beneath a confronting surface of the frame would enable Adam Jr. et al's cover to hide the edges of the cover in grooves in the frame as taught by Bargados et al, and thus reducing the precise manufacturing tolerance required of the cover, which would result in cost saving and guarantee covering of the exposed central portion of the pane, and having a glazing compound within the frame would enhance the securement of the frame to the pane as taught by Emmanuel.

6. Claim 56 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. (5866260) in view of Calabrese (2657795), Bargados et al (5809707), and Emmanuel (5836119).

Adams Jr. (figure 2) shows a glazing assembly comprising an insulating glass unit and a frame to which the insulating glass unit is mounted, the unit comprising first and second panes (col 1 lines 14-16, line 51) having an insulating glass unit (12) and a frame (26) to which the insulating glass unit is mounted, the unit having a first pane (21) having generally opposed inner and outer surfaces, the first pane having at least one edge received in the frame, a protective covering (22) is disposed over a portion of the outer surface of the second pane, the outer surface of the second pane having an unmasked apron extending between an outer periphery of the covering and an outer periphery of the second pane, the covering having at least one piece of masking material (22), the masking material being a flexible masking film.

Adam Jr. does not show the covering comprising a plurality of strips of masking material, glazing compound being located between the frame and the outer surface of the first pane but not between the frame and the outer surface of the second pane, the masking material extending beneath a confronting surface of the frame.

Art Unit: 3637

Bargados et al shows a covering material extending beneath a confronting surface of the frame (18) to hide the ends of the covering material in the grooves.

Emmanuel (figure 3) shows a window unit having a first and second pane (46, right and left respectively), glazing compound (83) located between the frame and the outer surface of the first pane (46 right) but not between the frame and the outer surface of the second pane (46, left).

Calabrese discloses a covering member being a plurality of strips of masking material.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams Jr. et al to show the covering comprising a plurality of strips of masking material as taught by Calabrese, glazing compound being located between the frame and the outer surface of the first pane but not between the frame and the outer surface of the second pane as taught by Emmanuel, the masking material extending beneath a confronting surface of the frame as taught by Bargados et al because having the cover made of a plurality of strips as taught by Calabrese would enable the covering of the unpainted area before painting, having the glazing compound only between the first panel and the frame but not the second pane and the frame would enhance the securing of the first panel to the frame as taught by Emmanuel, and having the masking material extending beneath a confronting surface of the frame would enable the hiding of the edges of the covering material in the grooves and thus provide complete coverage of the pane from external objects Bargados et al.

7. Claims 57-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. (5866260) in view of Calabrese (2657795), Bargados et al (5809707), and Emmanuel (5836119) as applied to claim 56 above and further in view of Hurst (3900102).

Adams Jr. et al as modified shows all the claimed limitations except for the covering having at least one tab or extension to facilitate removing the covering.

Hurst discloses having the covering material overlapping each other to form a continuous covering surface.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams Jr. et al's modified structure to the covering material overlapping each other because it would enable the formation of a continuous surface with strips of covering material.

Adams Jr. as modified shows all the claimed limitations including the covering having at least one tab or extension to facilitate removing the covering.

Per claims 59-60, Adams Jr. et al as modified shows all the claimed limitations except for the distance being at least 1/16 inch and about 1/8 inch.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams Jr. et al's modified structure to show the distance being at least 1/16 inch and about 1/8 inch because it would have been an obvious matter of design choice to show the distance being at least 1/16 inch and about 1/8 inch since applicant has not disclosed that the distance of 1/8 inch or 1/16 inch solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the predetermined distance being more than 1/8 inch.; furthermore, a change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

8. Claim 62 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. (5866260) in view of Schlicht et al (5123211) in view of Emmanuel (5836119).

Adams Jr. (figure 2) shows a glazing assembly comprising a transparent pane and a frame (26) to which the pane is mounted, the frame being made of wood, the frame receives an edge of the pane, the transparent pane having first and second generally opposed major surfaces, the pane having a protective covering (22) disposed over a portion of the first surface, the first surface having an unmasked apron extending between an outer periphery of the covering and an outer periphery of the pane, the covering comprising at least one piece of masking material, the material being a flexible film.

Adam Jr. does not show the frame comprising the wood being vinyl-covered wood or a tubular construction of metal or metal alloy, glazing compound between the frame and the pane, the masking material extending beneath a confronting surface of the frame but does not extend so far beneath the frame as to engage the glazing compound.

Schlicht et al shows a covering material (44) extending beneath a confronting surface of the frame (figure 12) but does not extend so far beneath the frame as to engage the glazing compound, the frame being made of metal.

Emmanuel (figure 3) shows a window unit having glazing compound (83) located between the frame and the pane.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams Jr. et al to show the glazing compound being located between the frame and the first pane as taught by Emmanuel, the masking material extending beneath a confronting surface of the frame but does not extend so far beneath the frame as to engage the glazing compound, the frame being metal alloy as taught by Schlicht et al because having the glazing compound only between the panel and the frame would enhance the securing of the

Art Unit: 3637

panel to the frame as taught by Emmanuel, and having the masking material extending beneath a confronting surface of the frame without touching the glazing compound would enable the secure hiding of the edges of the covering material in the grooves of the frame as taught by Schlicht et al, and having the frame made of metal as taught by Schlicht et al would form a strong supporting frame for a window.

Response to Arguments

9. Applicant's arguments with respect to claims 1, 6, 8-12, 48-51, 55-62 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art shows different covering means.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phi D A whose telephone number is 571-272-6864. The examiner can normally be reached on Monday-Tuesday, Thursday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 571-272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3637

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, consisting of a series of loops and a large, prominent oval at the end.

Phi Dieu Tran A

11/9/05